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IN THE
Supreme Court of the United States
October Term, 1947.

No. 664

ANDREW J. McPARTLAND, INC.,
Petitioner,

vs.

MONTGOMERY WARD & CO., INC.

*Petition and Brief in Support of Petition
for Writ of Certiorari.*

✓
EMMET L. HOLBROOK,
Attorney for Petitioner.

Errata.

Page 11—Line 6—Insert word “is” between the words
“it”—and “applied”.

Page 9—Line 3—“petitioner” should read “Montgom-
ery Ward’s”.

Page 10—Line 32—“a trade—” should be stricken out at
the end of the line and a comma in-
serted after “cancel”.

Page 11—Line 1—“mark” should be stricken out at the
beginning of the line.

Line 2—the question mark should be stricken
out and a comma substituted and the
word “A” should be changed from a
capital to a small letter.

Page 19—Line 14—“extended” is misspelled.

Page 20—Line 3—“R. 122-135” should read “R. 120-
130”.

Line 13—“R. 121” should read “R. 131”.

Line 18—“Marks” should read “Mark”.

Page 21—Line 36—“Snookum” should read “Skookum”.

Page 30—Line 16—“petition” is misspelled.

Line 23—the word “is” should be inserted be-
tween the words “which” and “en-
titled”.

Page 32—Line 6—“prohibited” is misspelled.

Page 34—Line 18—after the word “Act” should read:

“Section 14 applies to the cancella-”

Lines 28 to 33, inclusive, should read: “Any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this chapter, or under . . . the Act of February 20, 1905, may upon payment of the prescribed fee, apply to cancel said registration

.

(c) at any time ~~if~~ . . . its registration was obtained fraudulently or contrary”

Page 38—Line 22—“Sec. 14” should be stricken out and and “Section 14 applies” substituted.

Page 39—Line 4—“he” should read “the”.

Page 44—Line 34—the comma should be stricken out between “automobiles” and “motors” and the word “and” inserted.

Line 17—comma after “involved”.

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IN THE
Supreme Court of the United States

OCTOBER 1947 TERM.

ANDREW J. McPARTLAND, INC.,
Petitioner,

vs.

MONTGOMERY WARD & Co., INC.

No.

PETITION.

*To the Honorable Chief Justice and the Associate Justices
of the Supreme Court of the United States:*

The petitioner prays that a Writ of Certiorari issue to review the final order and judgment of the United States Court of Customs and Patent Appeals entered on November 29, 1947 (164 F. [2d] 603; 76 U. S. P. Q. 97, 35 C. C. P. A. [Patents]).

On February 25, 1948, an order was duly made by Mr. Chief Justice Fred M. Vinson extending the time for filing this petition to and including March 9, 1948. A copy thereof is attached.

Statement and Summary of Matters Involved.

The petitioner, Andrew J. McPartland, Inc., is a Connecticut corporation (R. 111-115), engaged, among other things, in the sale of storage batteries in interstate commerce under an assigned (R. 115-116), registered trademark "KWIXTART" (R. 5, 57, 87-89).

The respondent, Montgomery Ward & Co., Inc., is an Illinois corporation (R. 44), engaged, among other things, in the sale of storage batteries in interstate commerce in the same territory as petitioner (R. 12).

On March 24, 1944, Montgomery Ward & Co., Inc. petitioned (R. 44) the Commissioner of Patents to cancel the trademark "KWIXTART" duly registered by the Commissioner of Patents (on the ground that it was *not* descriptive but, at most, "suggestive" under the rule in *In re Pillsbury Flour Mills Co.*, 1935 C. D. 1, 23 U. S. P. Q. 168 [R. 65]), under No. 326,257 on July 23, 1935 for Electric Storage Batteries by Andrew J. McPartland under the Trade Mark Act of February 20, 1905 (R. 5, 57 87-89), and duly assigned to the corporate petitioner herein on April 28, 1937 (R. 115-116). The grounds specified were that Montgomery Ward & Co., Inc. was injured by said registration and that: (a) registrant, at the time of applying for registration, had never used the mark on electric storage batteries; (b) the registrant had abandoned the mark; (c) the mark is descriptive of the merchandise and not subject to registration under Section 5 of the Trade Mark Act of February 20, 1905 (15 U. S. C. A., Sec. 85) (R. 44). Issue was joined on all grounds by the filing of an answer on May 17, 1944 (R. 59).

A hearing was held before an Examiner of Interferences who rendered a decision on December 12, 1944, holding that: (a) registrant had used the mark on electric storage batteries in interstate commerce at the time of the application for registration; (b) the registrant had not abandoned the mark; and (c) "the notation 'KWIX-TART', being a mere misspelling of the words 'quick start', is merely descriptive and hence not registrable under the Act of 1905". The Examiner sustained the petition for cancellation and recommended cancellation (R. 61-64). No finding was made on the issue of "injury" to Montgomery Ward & Co., Inc.

On December 23, 1944, petitioner herein appealed to the Commissioner (R. 64-65), who filed a decision on November 16, 1945, affirming the decision of the Examiner (R. 65-67). In his decision, the Commissioner held that the mark "KWIXTART" had been registered "on authority of *Ex Parte Pillsbury Flour Mills Co.*, 1935 C. D. 1, 23, U. S. U. S. P. Q. 168" in which the mark "Minitmix" was registered for "a prepared mixture to be used in making biscuits"; that "The doctrine of that case was the law of the Patent Office at the time the McPartland registration issued, and the examiner was controlled thereby. But a few years later, in the case of *The Midy Laboratories, Inc.*, 26 C. C. P. A. 1294, 104 Fed. [2d] 617, the United States Court of Customs and Patent Appeals affirmed a Patent Office decision to the contrary; * * * " (R. 65). The Commissioner also held, in effect, that the mere fact of registration was sufficient evidence of "injury" to Montgomery Ward & Co., Inc., and concluded that "Because it is descriptive, McPartland 'was not entitled to the use of the mark at the date of his application for registration thereof' within the meaning of Section 13 of the Act; and the statute requires that 'the Commissioner shall cancel the registration'" (R. 67; 67 U. S. P. Q. 240).

Petitioner herein appealed to the United States Court of Customs and Patent Appeals on February 14, 1946 (R. 68). On July 5, 1946, the Lanham Trade Mark Act was approved and became effective July 5, 1947 (60 Stat. 427 *et seq.*, 15 U. S. C. A. Sec. 1051). Subsequently, on October 2, 1947, the appeal was argued, at which time "it was intimated from the bench that there was a possibility that the Trade Mark Act of July 6, 1946 (effective July 5, 1947) Chap. 540, 60 Stat. L. 427 *et seq.*, might have application to the issues here involved" (164 F. [2d] 603, 605). On October 7, 1947, the Court of Appeals requested counsel for the parties to file a supplemental brief on the following questions:

"One of the questions involved in the case is whether the so-called 'Lanham Trade-Mark Act', effective July 5, 1947, applies to the appeal pending in this court pertaining to the cancellation of a trade-mark registered under the Trade-Mark Act of 1905, which appeal was heard on October 2, 1947. If the Act applies, was it the purpose of the Congress, by the language of Sec. 2 (e) of the so-called 'Lanham Trade-Mark Act' which prohibits the registration of a mark which ' * * * when applied to the goods of the applicant is *merely descriptive or deceptively misdescriptive of them,*' to modify the meaning of the language of Sec. 5 U. S. C., title 15, sec. 85 of the Trade-Mark Act of 1905 which provided, in substance, that a trade-mark which was merely descriptive of the goods upon which it was used 'or of the character or quality of such goods, 'was not registrable? (Italics not quoted.)"

Five briefs of *amici curiae* were also filed, three of which were requested by the court (164 F. [2d] 603, 605).

Counsel for both of the *parties* contended that the Lanham (1946) Act applied but differed on the interpretation as to whether it changed the prohibition of the Act of 1905 regarding registration of "descriptive" marks. The briefs of *amici curiae* argued that the Lanham Act did not apply and that it did not change the rule of the prior act in relation to "descriptive" marks. The Court of Appeals arrived at the last stated conclusions, *but with a definite note of uncertainty* (164 F. [2d] 603, 608 [3]), and "that the term 'KWIXTART' is but a phonetic spelling of the term 'quick start' and was intended to describe merely that appellant's battery would start a motor or engine quickly" (Id, p. 604) and that, therefore, petitioner's mark was not entitled to registration under the Act of 1905 and that his registration granted in 1935 was properly cancelled by the Commissioner in 1944 (164 F. [2d] 603, 605, 608; 76 U. S. P. Q. 97; 35 C. C. P. A. [Patents] ...).

Recourse may not be had by the registrant-petitioner herein to the Federal District Courts for relief for the reason that Sections 4911-4915 of the Revised Statutes now prohibit such action where an appeal has been taken to the Court of Customs and Patent Appeals (44 Stat. 1336, sec. 8; U. S. C. A. tit. 35, secs. 59a-63). No further proceedings are possible and the judgment of the U. S. Court of Customs and Patent Appeals in this case is a final disposition of the controversy except for a review by the Supreme Court of the United States. The existing law makes the judgment of the Court of Appeals binding upon the Commissioner of Patents and not merely advisory.

Jurisdiction.

The jurisdiction of this court is based on Sections 195, 196a of the Judicial Code as amended (28 U. S. C. A. Sec. 308, 309a) and, since the questions presented arise under and involve the interpretation and application of the Trade Mark Acts of February 20, 1905 and July 5, 1946, and the due process and right to jury trial Amendments to the Constitution, on Article III, Section 2, and Amendments V and VII of the Constitution and 33 Stat. 726, Sec. 98; U. S. C. A. tit. 15, Sec. 18; 60 Stat. 440, Sec. 40, U. S. C. A. tit. 15, Sec. 1122; 18 Stat. 316, Sec. 2, and 36 Stat. 1167, Sec. 291, U. S. C. A. tit. 28, Sec. 772. (See accompanying Brief for elaboration on the matter of jurisdiction.)

Facts.

On March 8, 1935, Andrew J. McPartland filed an application in the United States Patent Office to register his trademark "KWIXTART" for electric storage batteries (R. 5).

A storage battery is a repository of electrolytic energy which is communicated or activated or released by closing the circuit of circulation or the contact of the conductor of the current.

Storage batteries are used to supply electricity for power, heat, lighting, radio, wireless and many other end purposes. They are adapted for use in automobiles, but that is *only one* of a large number of employments. When used in an automobile, it supplies electricity for the lights on the dash board, the lights in the body, the head and tail and stopping lights, the heater, the cigar lighter, the radio, the electric fan, the ignition and the accessory known as the "starter", the last named being something separate and apart from the storage battery. The "starter", *not* the battery, consists chiefly of an electric motor which is connected with the crankshaft. When the current is released from the battery to the "starter", the motion of the electric motor initiated thereby, sets in operation the mechanical attachment from the "starter" to the crankshaft which "cranks" or turns over the motor of the automobile which in turn sets in motion the series of gas explosions touched off by the sparks from the spark-plugs, resulting from the electricity supplied to them by the battery. Obviously, neither the function nor the character or quality of the battery in an automobile is to "start" it or the motor which drives it. A separate and distinct mechanical accessory has been separately distinguished by automotive engineers by specific terminology, namely, "starter". To say that the battery "starts" a gasoline automobile is as illogical and erroneous as to contend that the Preacher "tollled" the bell where "the Preacher told the Sexton and the Sexton tollled the bell." The Examiner of Interferences, the Commissioner and the Court of Appeals predicate their conclusions entirely on the use of the battery in an automobile and on the false premise that the battery "starts" the car (R. 62, 66, 164 F. [2d] 603; 76 U. S. P. Q. 97; 35 C. C. P. A. [Patents] . . .).

On April 2, 1935, registration was refused by the Examiner "on the ground that the mark is descriptive of the goods" (R. 82, 100-101). On April 2, 1935, McPartland

rejected that decision and insisted on registration (R. 83, 101).

On April 3, 1935, the same Examiner again refused registration on the same grounds (R. 83-84). On April 15, 1935, McPartland rejected this second refusal and insisted on registration (R. 84-86).

On April 15, 1935, on the statement of Patent Office officials, McPartland added the following to his application:

"No claim is made to the individual syllables of mark, each apart from the other" (R. 86).

This addition brought his case within the purview of the Patent Office decision in the "*Minitmix*" case (*In re Pillsbury Flour Mills Co.*, 1935 C. D. 1; 23 U. S. P. Q. 168) and the mark was passed for publication, published, and, no opposition having been filed, was duly registered and a Certificate of Registration thereof duly issued by the Commissioner of Patents on July 23, 1935 to McPartland (R. 86-87).

On April 28, 1937, McPartland duly assigned his Trade Mark and Registration and the good will of the business to his corporation, Andrew J. McPartland, Inc., which he formed under the laws of Connecticut on April 27, 1937 (R. 111-116).

On March 22, 1944, nine years after registration had issued to McPartland, Montgomery Ward & Co., Inc., alleging injury by reason of such registration, petitioned the Commissioner of Patents to cancel the registration on the grounds that (a) registrant had never used the mark at the time of his application; (b) that he had abandoned it; and (c) that the mark "is descriptive of the merchandise" and not subject to registration under Section 5 of the Trade Mark Act of February 20, 1905 (15 U. S. C. A. Sec. 85) (R. 44). The Examiner of Interferences found for registrant on the first two grounds (R. 61-62) and his

decision in that respect has not been called into question by anyone. The remaining ground, on which he found against the registrant (R. 61), was one over which he had no jurisdiction nine years after registration had issued and was one which could be litigated only in a court of competent jurisdiction, as we shall point out later.

The evidence introduced by Montgomery Ward & Co., Inc. before the Examiner on the last named ground, consisted of copies of advertisements by it in thirteen issues of The Saturday Evening Post between January, 1932 and October, 1942, and in ten issues of its catalogues between 1933 to 1940; advertisements of Sears, Roebuck & Co. in seven issues of its catalog between 1934 and 1943; advertisements of Spiegel, Incorporated, in two issues of its catalog in 1941 and 1942; and a single advertisement of Eaton's of Winnipeg, Canada, in its 1943 catalog (R. 14-15). All of these advertisements contained, somewhere in the body of the sales talks, the words "quick starts", "quicker starts", "quicker starting", "quick sure starts" or "quick sure starting" (R. 15-16). The first use of these words by Montgomery Ward & Co., Inc. with reference to storage batteries was in its Fall and Winter 1933-1934 catalogue (Ex. 26, p. 1; R. 14). This page contains descriptions of three of its storage batteries. As to one, "Ward's Riverside Winter King", the following expository matter appears in fine print beside a small picture of the battery:

"Built to specifications surpassing many world renowned batteries selling at much higher prices. The same battery that outperformed all others in the new power test described on opposite page. Heavier plates— $3/32$ of an inch (or $6/64$) in thickness, and deeper grids hold more life-producing lead oxide, giving extra power for quick starting in zero weather. In standard capacity tests as required by the S.A.E. the Winter King outperformed two other famous brands retailing at much higher prices. Yet the price is only slightly more than the usual standard battery. Rubber case—tested for high voltage resistance. All plate sizes from 13 to 21 plates. Shipping weights: 13-plate, 44 lbs; 15-plate, 50 lbs, other sizes 50 to 74 lbs. Not available. See shipping points at lower right."

It is on the basis of this insignificant, hidden prior use of "quick starting" (not even "quick start") in connection with the plates and grids of one of petitioner's storage batteries that cancellation of registrant's mark is predicated. This was not a trade-mark use; or a use analogous to a trade-mark use; it was an ordinary use of the English language for ordinary purposes of exposition. All the other pages of Exhibit 26 were published after March 6, 1935, registrant's date of first use and so cannot affect the validity of registrant's mark. They should be excluded. The second paper is a page from the spring and summer 1935 catalogue. Its date of publication is not of record, but as spring begins on March 21st, we cannot presume an earlier publication.

In 1941, more than six years after McPartland's registration of "KWIXTART", Montgomery Ward & Co. Inc. commenced marketing storage batteries with the mark "Kwik Start" stamped or impressed thereon and advertised them for sale under such mark in its 1941 through 1943 catalogue (R. 15).

The Questions Involved.

I.—Was petitioner deprived of his property without due process of law in violation of his Constitutional rights, secured by Amendment V to the Constitution of the United States, by the decision of the Commissioner of Patents, and the judgment of the United States Court of Customs and Patent Appeal affirming the same?

II.—Was Petitioner deprived of his right, secured by Amendment VII to the said Constitution and 18 Stat. 316, Sec. 2, 36 Stat. 1167, Sec. 291; U. S. C. A. Tit. 28, Sec. 772, to a trial by jury in a Federal Court having jurisdiction of the issues relating to his ownership and right to use the trademark "KWIXTART" on storage batteries, by the decision of the Commissioner of Patents, and the

judgment of the U. S. Court of Customs and Patent Appeals affirming the same?

III.—Does the Trade Mark Act of February 20, 1905, as amended, (33 Stat. 725, *et seq.*, U. S. C. A. Tit. 15, Sec. 81, *et seq.*), or the Lanham Trade Mark Act of July 5, 1946 (effective July 5, 1947) (60 Stat. 427, *et seq.*, U. S. C. A. Tit. 15, Sec. 1051, *et seq.*), or both apply to this Trade Mark and proceeding?

IV.—Was it the purpose of the Congress, by the language of Section 2 (e) of the so-called "Lanham Trade-Mark Act", which prohibits the registration of a mark which " . . . when applied to the goods of the applicant is *merely descriptive or deceptively misdescriptive* of them", to modify the meaning of the language of Section 5 (U. S. C. A., Title 15, Section 85) of the Trade-Mark Act of 1905 which provided, in substance, that a trade-mark which was merely descriptive of the goods upon which it was used "or of the character or quality of such goods", was not registrable?

V.—Does the Trade Mark Act of February 20, 1905 (33 Stat. 727, Sec. 13; U. S. C. A. Tit. 15, Sec. 93), empower the Commissioner of Patents or the Court of Customs and Patent Appeals to cancel a trade-mark on the ground that it is "descriptive of the character or quality of the goods on which they are used" nearly ten years after it had been duly registered under the Act on the ground that it was *not* "descriptive" but, at most, "suggestive" of a characteristic of the goods to which it was applied?

VI.—Does the Lanham Act of July 5, 1946 (effective July 5, 1947) (60 Stat. 433, Sec. 14; U. S. C. A. Tit. 15, Sec. 1064), empower the Commissioner of Patents or the Court of Customs and Patent Appeals to cancel a trade-

mark on the ground that it is "descriptive of the character or quality of the goods on which they are used"? A trade-mark duly registered nearly ten years before under the Trade Mark Act of February 20, 1905 on the ground that it was *not* "descriptive" but, at most, "suggestive" of a characteristic of the goods to which it applied?

VII.—Is the trade mark "KWIXTART", duly registered under the Trade Mark Act of February 20, 1905 for use on electric storage batteries, a mark "merely in words or devices which are descriptive * * * of the character or quality of such goods within the meaning of said Act", or is it, at most, suggestive?

VIII.—Is the Trade Mark "KWIXTART", duly registered under the Trade Mark Act of February 20, 1905, for use on electric storage batteries, a mark "merely descriptive" of such goods within the purview of the Lanham Trade Mark Act of July 5, 1946, or, is it, at most, merely suggestive?

The Reasons Relied on for the Allowance of the Writ.

(a) The questions involved are of great public interest.

(b) The Court of Customs and Patent Appeals has decided important questions of federal law which have not been, but should be, settled by the Supreme Court.

(c) The Court of Customs and Patent Appeals has decided a federal question in a way probably in conflict with applicable decisions of the Supreme Court.

(d) The Court of Customs and Patent Appeals has rendered a decision in conflict with the decisions of that Court and with Circuit Courts of Appeals on the same matter.

(e) Intervention of the Supreme Court is required in order authoritatively to interpret and apply the federal trade mark laws and dispel the clouds of confusion that currently beset this important phase of commerce.

Supporting Statements for the Reasons Relied Upon.

(a) That the questions involved are of great public interest is obvious from their very nature. The Court of Customs and Patent Appeals so considered them and requested briefs of *amici curiae* from the Commissioner of Patents; from the American Patent Law Association; from the Section of Patent, Trade Mark and Copyright Law of the American Bar Association; from the Trade Mark Committee of the New York Patent Law Association; and from Hon. Conder C. Henry, formerly Assistant Commissioner of Patents. The Lawyers' Advisory Committee of the United States Trade Mark Association requested and was granted leave to file a brief of *amici curiae*.

The questions involved affect thousands of registered trade marks that are in use throughout the United States. They, with other trade mark problems, have been the concern of Congress since 1933 and have been the subject of many extended Congressional Committee hearings and of several proposed statutes as well as the most recent enactment, the Lanham Trade Mark Act of July 6, 1946 (effective July 6, 1947). Numerous articles have been written on the subject, particularly within the last year, which indicate that widespread interest and confusion is extant.

"This bill attempts * * *. 4. To remedy constructions of the present acts which have in several instances obscured and perverted their original purpose. (Senate Report No. 1333 to 79th Congress, 2nd Session, Toulmin's Trade Mark Act of 1946, p. 134)."

It is urgent that an authoritative declaration by this Court of the correct interpretation and proper application of the provisions of the Federal Trade Mark Acts be made in order that commerce may be relieved of the serious uncertainty which now prevails and that legal doctrines in the field of federal trade-mark law may be clarified and clearly defined.

(b) The Court of Customs and Patent Appeals, by its judgment, has decided that the Commissioner of Patents had the jurisdiction and power under the Federal Trade Mark Acts of 1905 and 1946 to cancel a mark registered for nearly ten years, which the *then* Commissioner of Patents duly determined was not "descriptive" within the prohibitions of the Trade Mark Act, passed the same for publication and duly issued a Certificate of Registration, even though no such jurisdiction or power to cancel is conferred by the statutes.

The Court of Customs and Patent Appeals, by its judgment, has decided that the Commissioner of Patents had the jurisdiction and power, nearly ten years after registration, to "adjudge" as an administrative officer, whether or not the registrant at the time he applied for registration of his mark was entitled to the *exclusive* use thereof as distinguished from the *right "to the use of the mark"*, a function not delegated to him by the statute but which is solely the function of a Court and jury under the common law and Amendment V to the Federal Constitution.

The Court of Customs and Patent Appeals has decided in its opinion in this case, argued October 2, 1947 and decided November 29, 1947, that the Lanham Trade Mark Act of July 5, 1946 does not apply to the mark "KWIXTART" registered in 1935, or to the proceedings or the case which was before it.

The Court of Customs and Patent Appeals, by its decision filed on November 29, 1947, has decided that the *omission* from the Lanham Trade Mark Act of July 5, 1946 (effective July 5, 1947) of the prohibition from registration of marks which "merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods" and the *substitution* therefor of the prohibition from registration of a "mark which, (1) when applied to the goods of the applicant is *merely descriptive* or deceptively misdescriptive of them" does not effectuate a substantial change in the federal trade mark law.

All of these are important questions of federal law which have not been, but should be, settled by the Supreme Court.

(c) and (d) The decision of the Court of Customs and Patent Appeals is in conflict with the express mandate of Congress and contrary to the following controlling cases:

Charles of the Ritz, Inc. v. Beth Arden Sales Corp., 161 F. (2d) 234; 34 C. C. P. A. trade-mark "FEATHER-LIGHT" for face cream;

Vanity Fair Mills Inc. v. Pedigree Fabrics, Inc., 161 F. (2d) 226, 34 C. C. P. A. trade-mark "PECHGLO" for fabrics;

Arkell Safety Bag Co. v. Safepack Mills, 289 Fed. 616 (1923) trademark "SAFEPAK" for wrapping paper;

Plough, Inc. v. Intercity Oil Co., et al., 26 F. Supp. 978 (1939) trademark "EVER READY" for lubricating oils;

Chrysler Corp. v. Rolland S. Trott, 29 U. S. P. Q. 363 (1936) trademark "FLOATING POWER" for engine mountings;

Kenosha Full Fashioned Mills, Inc. v. Artcraft Hosiery Co., 37 T. M. Rep. 464 (1947) trademark "ART-CRAFT" for hosiery;

- Weber Foundations Co. Inc. v. Rand Rubber Co. Inc.*, 37 T. M. Rep. 472 (1947) trademark "SANI-BRIEF" for ladies nether wearing apparel;
- Henry Muhs Co. v. Farm Craft Foods, Inc.*, 37 F. Supp. 1013, 49 U. S. P. Q. 162—trademark "FARM-CRAFT" for food products;
- Solventol Chem. Prod. Inc. v. Langfield*, 134 F. (2d) 899, cert. denied 320 U. S. 743, 64 S. Ct. 44, 88 L. Ed. 441—trade marks "SOLVITE" and "SOLVENTOL" for cleaning fluids;
- W. G. Reardon Lab. Inc. v. B. & B. Exterminators, Inc.*, 71 F. (2nd) 515, trademark "MOUSE SEED" for rat poison in seed form;
- Globe-Werneck Co. v. Brown*, 121 F. 185—trademark "ELASTIC" for extending sectional bookcases;
- Holeproof Hosiery Co. v. Wallach Bros.*, 172 F. 857—trademark "HOLEPROOF" for hosiery;
- Hiram Holt Co. v. Wadsworth*, 41 F. 34—trademark "LIGHTNING HAYKNIVES" for hay knives;
- Leonard v. White's Golden Lubricator Co.*, 38 F. 922—trademark "VALVOLINE" for lubricating oils;
- Ex Parte Pillsbury Flour Mills Co.*, O. G. 3, 1935 C. D. 1, 23 U. S. P. Q. 168—trademark "MINITMIX" for prepared flour for biscuits.

(e) The lack of completeness and clarity in the statutes and the various amendments thereto and the existence of a variety of interpretations emanating from the decided cases in the Patent Office, the District Courts, the District Court of Appeals and the Court of Customs and Patent Appeals, inconsistent and irreconcilable, was recognized by Congress as early as 1938. At Hearings before the House Subcommittee on Patents on March 15, 1938 on bill H. R. 9041, 75th Congress, 3rd Session, the following pertinent statements were made:

(By Hon. Fritz G. Lanham, chairman, presiding)

"There seems to be two lines of thought with reference to trade mark legislation. In a general realization of the fact that business, in its various ramifications, has so progressed and developed since the enactment of our present trade-mark law, it is realized that in some respects the present statute is inadequate and perhaps archaic, or obsolete, and does not meet all of the demands of the present conditions of commerce. There are some who think we should have a new law; there are some who think we should amend the existing law" (p. 10).

(By Mr. Edward S. Rogers, Attorney, chairman Committee on Patents and Trade Marks, American Bar Association)

"That (the Trade-Mark Act of 1881) was supplemented or superceded, I should say, by the Act of 1905, which was based on the commerce clause and embraced trade-marks used in interstate commerce. That was supplemented by the Act of 1920 and both Acts have been amended from time to time. The result is we now have a rather confused situation which is difficult to understand, * * *, and it is hard for anyone to find out what the Federal statutory law is, because it is so badly scattered.

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"* * *. The preliminary question and the primary question, as I see it, is whether we should have a single statute which makes trade-mark property more secure, to the full extent of the congressional power over it, * * * or whether we should have just another practice act or trade-mark statute regulating proceedings only, like the present one. And even if we should decide to accept the second

alternative, a practice act, I submit to the committee that the present statute is in need of revision. It has existed for thirty odd years. In some respects, it has failed to meet the expectations of the proponents when it passed; *in some respects it has received a construction that I am very sure Congress never intended it to have.* It is confused; it is contradictory and it needs codifying." (Emphasis supplied.) (pp. 12, 13, 14.)

In 1943, Hon. Walter J. Derenberg, Counsel to the United States Patent Office, said:

"Not since the Court's decision in the *Shredded Wheat* case and the *Nu-Enamel* case in 1938 has the trade-mark profession had the benefit of an authoritative determination by the Supreme Court of any of the many controversial issues which have vexed trade-mark owners and trade-mark lawyers ever since the passage of the Act of 1905" (Derenberg, *Trade-Marks Ante Portas* [1943], 52 Yale L. J. 829, 831).

The enactment of the Lanham Act of 1946 (effective 1947), which supersedes the Act of 1905, preserves and enlarges the rights and protection of the Act of 1905, while, at the same time, repealing it, increases the degree of urgency for an authoritative interpretation of the law by the Supreme Court, not simply for this case, but for the benefit of all concerned with trade-marks.

"The new Trade-Mark Act, which by its terms does not become effective until July 5, 1947, contains a good many provisions which will have to be construed and clarified by the courts before their real meaning is established" (The New Trade-Mark Act, Memorandum prepared by the Lawyer's Ad-

visory Committee of the United States Trade-Mark Association [1946, p. 31]).

Wherefore, petitioner prays that this Court issue a Writ of Certiorari to the United States Court of Customs and Patent Appeals and/or to the United States Commissioner of Patents, directing said Court and/or the said Commissioner to send to this Court for a review of the decision and final judgment of the said United States Court of Customs and Patent Appeals rendered on November 29, 1947, a full transcript of the records in said United States Court of Customs and Patent Appeals, in a case entitled:

Patent -Appeal Docket

No. 5304

Cancellation No. 4376

Andrew J. McPartland, Inc.,

Registrant-Appellant,

v.

Montgomery Ward & Co., Inc.,

Appellee.

filed in the office of the Clerk of said Court on November 29, 1947, and that the decision of the said United States Court of Customs and Patent Appeals and/or of the said Commissioner of Patents, be reversed, and for such other relief in the premises as may be just.

Dated: New York, N. Y., February 27, 1948.

ANDREW J. McPARTLAND, INC.,

By: EMMET L. HOLBROOK,
Attorney for Petitioner.

Supreme Court of the United States

OCTOBER TERM, 1947.

ANDREW J. McPARTLAND, INC.,
Petitioner,

v.

MONTGOMERY WARD & CO. INC.

No.

Order Extending Time Within Which to File Petition for Certiorari.

UPON CONSIDERATION of the application of counsel for the petitioner,

IT IS ORDERED that the time for filing petition for certiorari in the above-entitled cause be, and the same is hereby, extended to and including March 9th, 1948.

(Signed) FRED M. VINSON,
Chief Justice of the United States.

Dated this 25th day of February, 1948.

Brief in Support of Petition for Writ of Certiorari.

The decision of the United States Court of Customs and Patent Appeals appears at R. 122-135 and is reported in 164 F. [2] 603; 76 U. S. P. Q. 97, 35 C. C. P. A. [Patents]).

The decision of the Commissioner of Patents appears at R. 65-67 and is officially reported in 67 U. S. P. Q. 240.

The decision of the Examiner of Interferences appears at R. 61-64 and is not officially reported.

The final judgment of the United States Court of Customs and Patent Appeals, dated November 29, 1947, affirming the decision of the Commissioner of Patents appears at R. 121.

Jurisdiction of This Court.

The jurisdiction of this court is based on Sections 195 and 196a of the Judicial Code as amended (28 U. S. C. A. Secs. 308, 309a), and since the questions presented involve the interpretation and application of the Trade Marks Acts of February 20, 1905, and July 5, 1946, and the due process and right to jury trial Amendments to the Constitution, on Article III, Section 2 and Amendments V and VII of the Constitution and on Section 18 of the Trade Mark Act of February 20, 1905 (33 Stat. 729, c. 592; U. S. C. A. tit. 15, sec. 97), Section 40 of the Lanham Trade Mark Act of July 5, 1946 (effective July 5, 1947, 60 Stat. 440, c. 540, U. S. C. A. tit. 15, sec. 1122).

Prior rulings of this Court on the question of jurisdiction to review decisions in trade-mark cases have no application here.

The character and quality of this case differ substantially and materially from those cases. Amendments and superseding legislation have so altered the statutory law as to enable this Court to review and correct the decision of the United States Court of Customs and Patent Appeals in this case. A first distinction found between the

reported decisions and this case is that the prior cases were decided prior to the alterations of the statutes. For example, *Postum Cereal Co. Inc. v. California Fig Nut Co.*, 272 U. S. 284, was submitted November 9, 1926 and decided January 1, 1927. The statute was changed March 2, 1927 (44 Stat. 1336, sec. 8; U. S. C. A., tit. 35, secs. 59a-63). In that case review was sought by appeal whereas the statute provides for writ of certiorari (33 Stat. 729, Sec. 17; U. S. C. A. tit. 15, sec. 97). Also, they were mostly "refusals to register" or "refusals to issue letters patent" by the Commission, which were purely administrative functions and not final determinations, whereas in our case the Commissioner, under the guise of a "cancellation proceeding" has actually "reviewed" an administrative action by his predecessor some ten years before, and has taken "judicial action." The Commissioner's action in the prior cases were within the purview of the judicial and administrative jurisdiction conferred on him by statute whereas in our case his action was wholly extrajudicial and beyond the powers prescribed for him by Congress. The decisions of the Court of Appeals for the District of Columbia in the jurisdictional cases were *not* final judgments but were wholly "advisory" whereas in our case the judgment of the Court of Customs and Patent Appeals is a "final judgment." This is a "case" of which jurisdiction to review is given by the Trade-Mark Acts of 1905 and 1946, an element absent in the other instances. Review by this Court is sought by writ of certiorari as the statute requires, whereas in nearly all of the former instances procedure by appeal was pursued and, in those instances where a writ was petitioned for, the disposition was based on the decisions where appeals had been attempted. The questions presented in this application were *not* presented to or considered or passed upon by this Court in *Pacific Northwest Co. v. Snookum Packing Co.*, (1931) 283 U. S. 858.

The Court of Customs and Patent Appeals in this case has entered a final judgment (R. 121). The jurisdiction formerly vested in the Court of Appeals for the District of Columbia on April 1, 1929 in patent and trade-mark appeals from decisions of the Commissioner of Patent was transferred to the Court of Customs and Patent Appeals by the Act of March 2, 1929 (45 Stat. 1476; U. S. C. A., tit. 28, sec. 309a). The jurisdiction originally vested in the former had been transferred to that Court upon its creation in 1893 from the Supreme Court of the District of Columbia (27 Stat. 434, c. 74). The act, which created the last mentioned Court, provided that said Court, sitting *en banc*, "shall hear and determine all appeals from the decision of the Commissioner of Patents in accordance with the provisions of Sections 4911 to 4915 inclusive of Chapter 1, Title LX of the Revised Statutes, Patents, Trade-Marks and Copyrights" (R. S. D. C. Sec. 780, p. 93), and that said Court shall send to the Commissioner of Patents a certificate of its proceedings which shall be entered of record in the Patent Office and shall govern the further proceedings in the case. Section 4911 of the Revised Statutes provided that a party to proceedings in the Patent Office, dissatisfied with the decision of the Commissioner of Patents, could appeal to the Supreme Court of the District of Columbia. Section 4915 of the Revised Statutes provided that such a party, *in addition* to the remedy provided in Section 4911, could bring a bill in equity for a patent (16 Stat. 204 *et seq.*; U. S. C. A. tit. 35, Secs. 59 *et seq.*; Derenberg on Trade-Mark Protection and Unfair Trading, p. 545, XI). The same rule applied to trade-mark cases (*Baldwin Co. v. Robertson* [1924], 265 U. S. 168; *Empire Crafts Corp. v. Nat'l Silver Co.*, 60 F. Supp. 1020; *Quaker Oats Co. v. General Mills*, 45 F. Supp. 462; *aff'd* 134 F. [2d] 429). The judgment in the equity suit was appealable to the Supreme Court of the District

of Columbia and reviewable, by appeal, by this Court (*Baldwin Co. v. Robertson, supra*).

When the jurisdiction of the Supreme Court of the District of Columbia on appeals from decisions of the Commissioner of Patents was transferred to the Court of Appeals for the District of Columbia by the Act of February 9, 1893, the *additional* remedy provided by Section 4915 of the Revised Statutes was preserved. It was because of the absence of finality in the decisions of said Court of Appeals in such cases and the existence of the *additional* remedy which carried with it the right to review, *with finality*, in the same Court of Appeals and *also to review by this Court*, that this Court, in *Frasch v. Moore*, 211 U. S. 1, held that a decision by the Court of Appeals of the District of Columbia on appeal from the Commissioner of Patents under Revised Statutes, Sections 4914, 4915, Sec. 9 of the Act of February 9, 1893, c. 74, 27 Stat. 434 and Section 780, Revised Statutes of the District of Columbia, is *interlocutory and not final* and is not reviewable by this Court under Section 8 of the Act of February 9, 1893, either by appeal or writ of error.

Section 9 of the Trade-Mark Act of February 20, 1905 (U. S. C. A., tit. 15, Sec. 89) provided for appeals by parties dissatisfied with the decision of the Commissioner of Patents to the Court of Appeals for the District of Columbia and the bill in equity remained an additional remedy in the event of an adverse decision by said Court of Appeals. Section 18 of that Act (U. S. C. A., tit. 15, Sec. 98) provided:

"Sec. 18: That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this Act in the same manner as provided for patent cases by the Act creating the circuit court of appeals" (33 Stat. 729—Act of Feb. 20, 1905, Ch. 592).

Effective February 13, 1925, Section 240 of the Judicial Code (U. S. C. A., tit. 28, sec. 347) was amended to read, in part, as follows:

“Certiorari to circuit courts of appeals and Court of Appeals of the District of Columbia; appeals or writ of error to Supreme Court from circuit courts of appeals in certain cases; other reviews not allowed.

(a) In any case, civil or criminal, in a circuit court of appeals or in the Court of Appeals of the District of Columbia, it shall be competent for the Supreme Court of the United States, upon the petition of any party thereto, whether Government or other litigant, to require by certiorari, either before or after a judgment or decree by such lower court, that the cause be certified to the Supreme Court for determination by it with the same power and authority, and with like effect, as if the same had been brought there by unrestricted writ of error or appeal.” (Act of Feb. 13, 1925, c. 229, sec. 1., 43 Stat. 938.) (Note that the statute is erroneously quoted in U. S. C. A., tit. 28, sec. 347.)

The rule still obtained that decisions by the said Court of Appeals in such cases of appeals from the Commissioner were advisory and not final and, therefore, not reviewable by this Court while a review *could* be had of a decision of the same Court of Appeals on a judgment or decree of a District Court in an equity suit pursuant to the provisions of Section 4915 of the Revised Statutes.

By Section 11 of the Act of March 2, 1927, Congress amended Section 4915 of the Revised Statutes (U. S. C. A., tit. 35, Sec. 63) so as to render the remedies alternative. From that date, a party dissatisfied with a decision of the Commissioner was required to elect between an appeal to

the said Court of Appeals or to bring suit in equity pursuant to Section 4915 of the Revised Statutes. He no longer had both remedies. His election to pursue one precluded him from the others. *Wettlinger v. Robin*, 29 F. (2d) 573; *Bakelite Corp. v. Nat'l Aniline & Chem. Co.*, 83 F. (2d) 176. Hence, the element of *finality* was added to the judgment of the Court of Appeals of the District of Columbia in cases appealed thereto from the Commissioner of Patents and, under the statute, became binding on the parties and the Commissioner.

Prior to the amendment, the procedure permitted an appeal from the decision of the Commissioner to the Court of Appeals and, in the event of an adverse decision there, a suit in equity, the judgment in which again was reviewable by the same Court of Appeals and by this Court on writ of certiorari. The purpose of the amendment was to reduce the number of possible appeals and preserve to litigants the option of producing new evidence in a suit in equity in lieu of an appeal to the Court of Appeals. If the parties wished to proceed on the record in the Patent Office the amendment provided a speedy disposition with a *final judgment* in the Court of Appeals. It was not necessary for any further amendments to give this Court jurisdiction to review such a judgment in view of Section 18 of the Act of February 20, 1905 and Section 240 of the Judicial Code, both quoted above. Certainly, it was not the intent of Congress to penalize parties who lessen litigation and adopt the simple, swift course for the disposition of their controversies by withholding from them the right to review by this Court by writ of certiorari. On the contrary, it is more consonant with the Congressional attitude to preserve to such litigants, if not to reward them with, the right to a final review by this Court by certiorari.

Subsequent to that amendment and by Act of March 2, 1929, c. 488, Sec. 2(a), (d), (45 Stat. 1476; June 7, 1934, c. 426, 48 Stat. L. 926; U. S. C. A. tit. 28, Sec. 309a), the

jurisdiction of the Court of Appeals of the District of Columbia as of prior to April 1, 1929, was transferred to the Court of Customs and Patent Appeals.

The Lanham Trade-Mark Act of July 5, 1946 (effective July 5, 1947, 60 Stat. 427, Secs. 1, *et seq.*; U. S. C. A. tit. 15, Secs. 1051, *et seq.*), which superseded the prior trade-mark acts, continued the alternative remedies mentioned above and provided:

"Section 40. Writs of certiorari may be granted by the Supreme Court of the United States for the review of *cases* arising under this Act in the same manner as provided for in cases under the patent laws." (Emphasis supplied.) (60 Stat. 440, Sec. 40; U. S. C. A., tit. 15, Sec. 1122.)

The word "*cases*" is used in a comprehensive all-inclusive sense in the trade-mark and patent acts to identify contested proceedings in the Patent Office as well as the courts. For example: R. S. 4905 (16 Stat. 204, Sec. 43; U. S. C. A. tit. 35, Sec. 53) authorizes the Commissioner of Patents to "establish rules for taking affidavits and depositions in *cases* pending in the Patent Office"; R. S. 4906 (16 Stat. 204, Secs. 44, 45; U. S. C. A. tit. 35, Sec. 54) provides for subpoenas to compel the attendance of witnesses "in any contested *case* pending in the Patent Office"; R. S. 4913 (44 Stat. 1336, Sec. 10; U. S. C. A., tit. 35, Sec. 61) requires that "The party appealing (to the Court of Customs and Patent Appeals, or its predecessor) shall lay before the court certified copies of all the original papers and evidence in the *case*,"; R. S. 4914 (16 Stat. 204, Sec. 50; U. S. C. A. tit. 35, Sec. 62) requires the said Court of Appeals to return a certificate of its proceedings and decision "after hearing the *case*"; Section 7 of the Act of 1905 (33 Stat. 726, Sec. 7; U. S. C. A. tit. 15, Sec. 87) provides for notice to applicant "in all *cases*

where notice of opposition has been filed"; Section 2 (a) of the Act of March 2, 1929, amending the Judicial Code (45 Stat. 1476, Sec. 2[a]; 48 Stat. 926, c. 426; U. S. C. A., tit. 28, Sec. 309 a) provides:

"Sec. 309 a. *Jurisdiction in Patent Cases.*

(a) The jurisdiction vested prior to April 1, 1929, in the United States Court of Appeals for the District of Columbia, in respect of appeals from the Patent Office *in patent and trade mark cases* is vested in the United States Court of Customs and Patent Appeals." (Emphasis supplied.)

In the same statutes the limited words of "suits at law and in equity" (33 Stat. 727, Sec. 17, U. S. C. A. tit. 15, Sec. 97) and "actions" (60 Stat. 440, Sec. 39, U. S. C. A. tit. 15, Sec. 1121) are used in conferring original jurisdiction of suits or actions brought under the Acts on the district courts and appellate jurisdiction on the circuit courts of appeal of the United States and the United States Court of Appeals for the District of Columbia, without regard to amount in controversy or diversity or lack of diversity of citizenship of the parties.

In the case of *In re Pacific Railway Co.*, 32 F. 241, at page 255, the Court said:

"The judicial article of the constitution mentions cases and controversies. The term 'controversies', if distinguishable at all from 'cases', is so in that it is less comprehensive than the latter, and includes only suits of a civil nature. (citing.) By cases and controversies are intended the claims of litigants brought before the courts for determination by such regular proceedings as are established by law or custom for the protection or enforcement of rights, or the prevention, redress, or pun-

ishment of wrongs. Whenever the claim of a party under the Constitution, laws, or treaties of the United States take such a form that the judicial power is capable of acting upon it, then it has become a *case*. The term implies the existence of present or possible adverse parties whose contentions are submitted to the courts for adjudication." (Emphasis supplied.)

In the case of *Osborn v. Bank of United States*, 9 Wheat, 819, this Court said:

"This clause enables the judicial department to receive jurisdiction to the full extent of the Constitution, laws, and treaties of the United States, when any question respecting them shall assume such a form that the judicial power is capable of acting on it. That power is capable of acting only when the subject is submitted to it by a party who asserts his rights in the form prescribed by law. It then becomes a *case*, and the Constitution declares that the judicial power shall extend to all *cases* arising under the Constitution, laws and treaties of the United States." (Emphasis supplied.)

The erroneous exercise of judicial jurisdiction by the Commissioner and the Court of Customs and Patent Appeals (see Point I, post) is, in itself, judicial action which gives this Court the right to review. *Pope v. United States*, 323 U. S. 1.

The foregoing were quoted with approval by this Court in *Muskraat v. United States*, 219 U. S. 346, 356, 357.

This Court may grant "writs of certiorari . . . for the review of *cases* arising under this Act" 33 Stat. 729, Sec. 17; U. S. C. A., Tit. 15, Sec. 97; 60 Stat. 440, Sec. 40; U. S. C. A., Tit. 1122) and, since this is a "*case* arising

under this Act", such a writ may issue to review the *final judgment* of the Court of Customs and Patent Appeals here.

In *Baldwin Co. v. Robertson* (1924) 265 U. S. 168, this Court reviewed by appeal a final judgment in a trade-mark case where resort was had to bill in equity under R. S. 4915. The only material difference between the *final judgment* in such a case and that of the Court of Customs and Patent Appeals is that the former is based on a more extended record of evidence whereas the latter is founded on the evidence presented before the Patent Office.

The judicial power is the power of a court to decide and pronounce a judgment and carry it into effect between persons and parties who bring the case before it for decision. Miller on the Constitution, page 314; *Muskra v. United States*, 219 U. S. 346, 356.

The Commissioner acted in this case in a judicial capacity. *Atkins v. Moore*, 212 U. S. 285, 290.

The Act of 1905 "empowers" the Examiner in charge of interferences to "hear and determine" (33 Stat. 727, Sec. 13; U. S. C. A. title 15, Sec. 93). The Act of 1946 empowers the Examiner "to determine and decide the respective rights of registration" (60 Stat. 434, Sec. 17; U. S. C. A. title 15, Sec. 1067).

His action in cancelling petitioner's registration of nearly ten years standing resulted in a deprivation of petitioner's property. For the federal certificate of trade mark registration is property. *Hanover Star Milling Co. v. Metcalf*, 240 U. S. 357, 60 L. Ed. 713; *Trade-Mark Cases*, 100 U. S. 82, 92, 93, 25 L. Ed. 550; *Time Inc. v. Violine Corp.*, 40 F. Sup. 249; *House of Westmore v. Denny*, 151 F. (2d) 261; *Paris Medicine Co. v. Brewer & Co.*, 17 F. Sup. 97. Where the culminating act interferes with the person or property the proceeding is judicial. *Atkins v. Moore* (*supra*).

The case also comes into the Court of Appeals "by a party who asserts his rights" under the federal Constitution and statutes "in the form prescribed by law". The jurisdiction transferred to the Court of Appeals in trade mark cases is to "hear and determine" and a *final judgment now* results.

Therefore, the proceedings in this case in the Patent Office and in the Court of Customs and Patent Appeals are judicial proceedings, a "*case*" within the purview of Section 18 of the Trade-Mark Act of 1905 (33 Stat. 729; U. S. C. A. tit. 15, Sec. 98) and of Section 40 of the Trade-Mark Act of 1946 (60 Stat. 440; U. S. C. A., tit. 15, Sec. 1122), and the *judgment, now being final*, may be reviewed by this Court on writ of certiorari.

Facts.

The facts are stated in the petition and will not be repeated here.

POINT I.

The Commissioner had no power to cancel petitioner's registered trade mark on the ground specified in his decision (Questions I, II, V and VI).

In the Act of 1905 the term "trade-mark" includes any mark which entitled to registration under the terms of this act, and whether registered or not (33 Stat. 730, Sec. 29; U. S. C. A. Tit. 15, sec. 108) while the Lanham Act of 1946 provides that the term includes any word, name, symbol, or devise or any combination thereof adopted and used for a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others (60 Stat. 440, Sec. 45; U. S. C. A. Tit. 15, sec. 1127).

The legal doctrines of trade-mark law are basically part of the common law. The right to "use" a trade-mark and the right to the universal "*exclusive use*" of a trade-mark are separate and distinct common law rights. In order to secure those engaged in commerce, particularly in interstate commerce, Congress clothed those common law rights with a cloak of federal protection by the Act of 1905 (15 U. S. C. A., Sec. 81, *et seq.*). By that Act, Congress prohibited deceptive, false and fraudulent marks and the false and fraudulent use of marks under penalty (33 Stat. 727, Secs. 5, 25; U. S. C. A. Tit. 15, Secs. 85, 104), conferred on every registrant the right to resort to the Federal Courts in all matters relating to his mark and to infringement thereof, regardless of the usual limitations to diversity of citizenship, amount in controversy, etc., the right to treble damages, constituted the registration *prima facie* evidence of ownership and, in assessing profits in infringement cases, required the plaintiff to prove defendant's sales only (33 Stat. 728, Secs. 16-20; U. S. C. A. Tit. 15, Secs. 96-100). This access to the Federal Courts included cases involving the registrant's common-law ownership and right to use his trade-mark. At common law, the right to a trial by jury of such issues was secured to one claiming the right to use a mark. Amendment VII to the Constitution preserves that common law right in the Federal Courts. Section 2, 18 Stat. 316, and Section 291, 36 Stat. 1167 (U. S. C. A., Tit. 28, Sec. 772) provides for a jury trial of such cases in the federal courts.

The Act directs the Commissioner to issue a certificate of registration to an applicant "on the filing of an application for registration of a trade mark which complies with the requirements of this act, and the payment of the prescribed fees, if no notice of opposition is filed within said time", namely, thirty days after publication of the mark in the Official Gazette of the Patent Office (33 Stat. 727, Sec. 6, U. S. C. A., Tit. 15, Sec. 86).

The requirements of this act were complied with in this case and McPartland became endowed with the rights conferred by Congress by the aforesaid enactment.

The Commissioner of Patents is an administrative officer. He is required to register Trade-Marks except those in the prohibited categories. His jurisdiction and duties are to register Trade-Marks which are entitled to be registered under the Act and to refuse registration to such marks as are denied the benefits of the Act.

When the application, on its face, meets with the requirements and no opposition is filed objecting to registration he acts solely administratively. When opposition is filed, he is endowed with limited judicial functions to determine whether or not, in his opinion, the mark is entitled to registration by the applicant. Once he makes the judicial determination that a mark is entitled to registration and registers the same, he has exhausted the authority conferred on him by the statute. The same rule applies in patent cases. *Baldwin Co. v. Robertson*, 265 U. S. 168, 180. In trade-mark cases, however, Congress vested in him by Section 13 of the 1905 Act, the authority and power to cancel registration *only where it is established before the examiner* "that (1) the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or (2) that the mark is not used by the registrant, or (3) has been abandoned" (33 Stat. 729; 15 U. S. C. A., Sec. 93). No power, jurisdiction or authority was granted to the Commissioner to cancel a registration on the ground that the mark is "descriptive".

The Second and Third categories are not here involved, since both of these issues were resolved in registrant-petitioner's favor. The first ground was the basis of the Commissioner's holding that "Because it (KWIXTART) is descriptive McPartland 'was not entitled to the use of the mark at the date of his application for registration thereof' within the meaning of Section 13 of the Act, and

the statute requires that 'the Commissioner shall cancel the registration' " (R. 67). The right to *use* the trade mark is a substantive right independent of and not created by the Trade Mark Act. The Act permits the registration of some marks, not every mark. Even though a mark may not be registered under the act it may be *used* and be entitled to protection in equity courts. By *use* it may become entitled to registration under the act. (Under the Lanham Act a "descriptive" mark, if registered, could *not* be cancelled after five years [60 Stat. 433, Sec. 14; U. S. C. A. Tit. 15, sec. 1064].) The Trade Mark Act merely accords to registered marks the recourse to the Federal Courts, and a rule of evidence which places the burden on a contestant of going forward with the proof to overcome the legal presumption of the registrant's rights to the *exclusive use* of the mark. The right to the *use* and the right to the *exclusive use* of a mark are two separate matters. The evidence in this case, directed solely to the claim of "descriptiveness" was, as a matter of law, wholly insufficient to overcome the *prima facie* evidence of ownership which the certificate of registration supplied. A party may have the right to the *use* of a descriptive mark which could not be registered under the act. *Bailly v. Nashawannuck*, 10 N. Y. Supp. 224. A right to *use* a trade mark may exist at the time it first is *used* without a concurrent right to its *exclusive use* being present. *But the right to the exclusive use may accrue at some time subsequent time*. Hence, cancellation by the Commissioner of a registered mark is authorized *only* where it is proved "that the registrant was not entitled to the *use* of the mark at the date of his application" (33 Stat. 727, Sec. 3, 15 U. S. C. A. Sec. 93). Congress thereby reserved for adjudication by the courts and juries, *not* by the Commissioner, of the common law right to the *exclusive use* of a trade mark, at the time such right is challenged, endowing the registrant with a legal

presumption of the right of such *exclusive use*, once it has been registered.

Sec. 46(b) of the Lanham Act provides:

“(b) Registration now existing under the Act of March 3, 1881, or the Act of Feb. 20, 1905, shall continue in full force and effect for the unexpired terms thereof and may be renewed under the provisions of Section 9 of this Act. *Such registrations and the renewals thereof shall be subject to and shall be entitled to the benefits of the provisions of this Act to the same extent and with the same force and effect as though registered on the principal register established by this Act except as limited in sections 8, 12, 14 and 15 of this Act*” (Emphasis supplied). (60 Stat. 443, Sec. 46(b); U. S. C. A., tit. 15, Sec. 1128.)

The present controversy is not concerned with Secs. 8, 12, or 15 of the Lanham Act. Sec. 14 to the cancellation of marks registered under the Acts of 1881 and 1905, as well as the Lanham Act (60 Stat. 433; U. S. C. A., tit. 15, Sec. 1064).

The Court of Customs and Patent Appeals has erroneously quoted Section 14 of the Lanham Act (164 F. [2d] 603, 606). This resulted from a misapprehension of the disjunctive clauses of subsection (c) of that Section.

The only portions of Section 14 which could be pertinent are as follows:

“Any person who believes that he is or will be damaged by this Act, * * * or the Act of February 20, 1905, may upon the payment of the prescribed fee, apply to cancel said registration—

(c) at any time if * * * its (the trade mark's) registration was obtained fraudulently or contrary

to the provisions * * * of subsections (a), (b), or (c) of Section 2 of this Act for a registration hereunder, or contrary to *similar* prohibitory provisions of said prior Acts for a registration thereunder, * * * or if the mark was registered under * * * the act of February 20, 1905, and has not been published under the provisions of subsection (c) of Section 12 of this Act; * * * " (60 Stat. 433, Sec. 14; U. S. C. A., tit. 15, Sec. 1064).

The basis of this cancellation proceeding was that the trade mark is "descriptive". Subsections (a), (b) and (c) of Sec. 2 of the Act prohibited registration of immoral, deceptive, scandalous matter, marks comprising the Flag, coat of arms, or other insignia of government or political subdivision thereof, foreign or domestic marks and marks comprising a name or portrait or signature identifying a particular living individual, etc., and do not contain any prohibition against registration of "descriptive" marks. The cancellation of the registration of marks registered contrary to "similar prohibitive provisions" of the Act of 1905 is all that is prescribed by the Lanham Act which, by Section 46(a) repeals the Act of 1905. Under subsection (c) of Section 14, if the mark was registered under the Act of 1905 and has not been published under the provisions of subsection (c) of Section 12 of the Lanham Act, cancellation may be made on the ground that registration was made contrary to "prohibitory provisions" of the Act of 1905 other than those "similar" to the prohibitions of subsections (a), (b) and (c) of Section 2 of the Lanham Act, but only on the ground that the mark would fall within the prohibited categories contained in subsections (d), (e) or (f) of Section 2 of the Lanham Act.

The "descriptive" prohibitions of the Lanham Act are contained in subsection (e) of Section 2 of that Act, the only pertinent part of which permits the refusal of regis-

tration of a mark "which (1) when applied to the goods of the applicant is *merely descriptive or deceptively misdescriptive* of them" (Emphasis supplied) (60 Stat. 428, Sec. 2[e]; U. S. C. A., tit. 15, Sec. 1054[e]). The Act of 1905 (now repealed), read: " * * * Provided that no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods * * * shall be registered under this Act; * * * " (33 Stat. 726, Sec. 5; U. S. C. A., tit. 15, sec. 85). Thus, the Lanham Act eliminates the prohibition against registration of marks which consist "merely in words or devices which are descriptive * * * of the character or quality of such goods" and confines the requirement of refusal of registration *solely and only* to marks which are "merely descriptive or deceptively misdescriptive". The mark "KWIXTART" applied to storage batteries does not fall within the prohibited categories.

A painstaking examination of Section 14 of the new Act will disclose that under the terms of the Act, as written, a 1905 registration can no longer be canceled because it is descriptive, whether of the goods in connection with which it is used, or of the character or quality of those goods; nor, for that matter, because it is confusingly similar to a prior mark, or because it is a name not distinctively displayed, or because it is merely a geographical term. Although the Act elaborately provides for the cancellation of 1905 registrations on the minor and unimportant grounds, hitherto available but seldom availed of, there's not a word about cancellation on the major and important grounds—including descriptiveness—Congress obviously reserving the issue of the right to the exclusive use of a mark for trial by competent courts and juries.

Remark that the cancellation provisions of the Lanham Act, which we have just quoted, do *not* include as a ground therefor "descriptiveness" of the mark. For it

is subsection (e) of Section 2 of that Act which contains the prohibition of marks which are "merely descriptive or deceptively misdescriptive" of the goods to which they are applied (60 Stat. 428, sec. 2[e]; U. S. S. A. tit. 15, sec. 1052[e]).

The Lanham Act provides:

"Section 46(a). This Act shall be in force and take effect one year from its enactment, *but except as otherwise herein specifically provided shall not affect any suit, proceeding, or appeal then pending.*" (60 Stat. 444, Sec. 46[a]; U. S. C. A. Tit. 15, quoted in notes to Sec. 1051.)

"Section 49. Nothing herein shall adversely affect the rights or the enforcement of rights in marks acquired in good faith prior to the effective date of this Act." (60 Stat. 443, Sec. 49; U. S. C. A. Tit. 15, quoted in notes to Sec. 1051.)

When the provisions of the Lanham Act quoted above are considered in connection with the last clause of subsection (c) of Section 14 of said Act, it is obvious that, where a mark has been registered under the Act of 1905 and has not yet been published under the provisions of subsection (c) of section 12 of the Act (and such is this case), cancellation may be had if at all, *only* on the grounds specified in Section 13 of the Act of 1905, namely, (1) that the registrant was not entitled to the use of the mark at the date of his application for registration thereof or (2) that the mark is not used by the registrant, or (3) has been abandoned. There is absolutely no provision of "descriptiveness" as a ground for cancellation by the Commissioner in either of the Acts of 1905 or 1946.

The Commissioner, therefore, had no power under the Trade Mark Acts of 1905 or 1946 to cancel petitioner's

trade-mark "KWIXTART" on the ground stated in his decision, and, by his unauthorized action, petitioner has been deprived of his right to a jury trial of the issues in a court of competent jurisdiction and of his property without due process of law.

POINT II.

The Lanham Trade Mark Act of 1946 applies in this case (Question III).

Sec. 46(b) of the Lanham Act provides:

"(b) Registration now existing under the Act of March 3, 1881, or the Act of Feb. 20, 1905, shall continue in full force and effect for the unexpired term thereof and may be renewed under the provisions of Sec. 9 of the Act. Such Registrations and the renewals thereof *shall be subject to and shall be entitled to the benefits of the provisions of this Act to the same extent and with the same force and effect as though registered on the principal register established by this Act except as limited in Sections 8, 12, 14 and 15 of this Act*" (Emphasis supplied).

The present controversy is not concerned with Sec. 8, 12, or 15 of the Lanham Act. Sec. 14 to the cancellation of marks registered under the Acts of 1881 and 1905, as well as the Lanham Act (60 Stat. 433; U. S. C. A., tit. 15, Sec. 1064).

Section 47(b) of the Act provides that

"In any case in which an appeal is pending before the United States Court of Customs and Patent Appeals. * * * at the effective date of this Act, the court, *if it be of the opinion that the provisions of*

this Act are applicable to the subject matter of the appeal (italics supplied),

[1] may apply such provision or

[2] may remand the case to the Commissioner * * *

[A] for the taking of additional evidence * * *
or

[B] for reconsideration of the decision on the record as made, as the appellate court may deem proper”.

This appeal, having been filed on February 14, 1946, and heard on October 2, 1947, was unquestionably “pending” before the Court of Customs and Patent Appeals on July 5, 1947, “the effective date of this Act”. This being established, the Court next was required to inquire whether the provisions of the Act “are applicable to the subject matter of the appeal”.

As the subject matter of this appeal is the cancellation of a federal trade-mark registration, and as the Lanham Act is the sole extant federal statute providing for the cancellation of such registrations, all other statutes having been repealed (Sec. 46[a]), there can be no doubt that the provisions of the Act “are applicable to the subject matter of the appeal” and that the Court could not well be of any other opinion. True, the other Acts have been repealed only “insofar as they are inconsistent herewith”, but as Section 13 of the 1905 Act is plainly inconsistent with Section 14 of the Lanham Act (both relating to cancellation), the former has been repealed and the later governs. Moreover, Section 47(a) unequivocally continues the prior Acts in force for the *single* purpose of permitting continued prosecution of applications filed under them: “and said Acts are hereby continued in force to this extent and for this purpose *only*, notwithstanding the foregoing general

repeal thereof." The 1905 Act is *not* continued in force to permit continued prosecution of cancellation proceedings brought under it. The applicability of the new Act being thus established, the Court was accorded either of two courses: 1 or 2 above.

If it pursued course 2 and remanded the case to the Commissioner it may do so for either of two purposes: A or B above. As there seems to be no good reason why either party should wish or need to take additional testimony, and as this Court may decide the questions of law presented without the Commissioner's reconsidered opinion on the record as made, we respectfully suggest that the Court should pursue course 1 and proceed to apply the provisions of the Lanham Act to the instant case.

Therefore the provisions of the statute quoted above constitute a Congressional mandate to apply "the benefits of the provisions of this (Lanham) Act" to petitioner's mark registered under Act of 1905.

POINT III.

The rule restricting registration of "descriptive" marks was changed by the Lanham Trade Mark Act of 1946 (Question IV).

The basis of this cancellation proceeding was that the trade mark "KWIXTART" applied to storage batteries is "descriptive".

The "descriptive" prohibitions of the Lanham Act are contained in subsection (e) of Section 2 of that Act, the only pertinent part of which permits the refusal of registration of a mark "which (1) when applied to the goods of the applicant is *merely descriptive or deceptive mis-descriptive of them*" (60 Stat. 428, Sec. 2; U. S. C. A., Tit. 15, Sec. 1052 [e]). The act of 1905 (now repealed) read:

“ . . . Provided, That no mark which consists . . . merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods . . . shall be registered under this Act. . . . ” (33 Stat. 726, Sec. 5 [b] U. S. C. A. Tit. 15, Sec. 85).

Thus, the Lanham Act *eliminates* the prohibition against registration of marks which consists “merely in words or devices which are descriptive . . . of the character or quality of such goods” and *confines* the requirement of refusal of registration solely and *only* to marks which are “merely descriptive or deceptively misdescriptive” of the goods. This alteration of the law was deliberately done by Congress with the intent to render incontestible marks registered under the Act of 1905 which might be considered as “merely in words or devices . . . descriptive . . . of the character or quality” of the goods.

The rule was stated by the Supreme Court in *Pirie v. Chicago Title & Trust Co.*, 182 U. S. 438 at 448:

“When the purpose of a prior law is continued usually its words are, and an omission of the words implied an omission of the purpose.”

The purpose of the Lanham Act is to bring the trade mark law abreast of the times and conform it to the changing conditions of commerce. It is designed to abolish the archaic application of what might be termed the “ancient law” in the field. (See matter quoted on pages 12 and 16 to 18 of the annexed petition.)

The statement of the Managers on the part of the House on the disagreeing votes of the two Houses on the amendments of the Senate to the bill (H. R. 1654) very definitely and tersely states: “Under the House bill which ultimately was passed as the Lanham Act, a mark is re-

fused registration *only* if it is "merely descriptive". (Emphasis supplied.) The Senate by its proposed Senate Amendment No. 1 sought to change "the House provisions by refusing registration to a mark which, when applied to the goods of the applicant is descriptive" and the bill was passed as formulated by the House on this point after the Senate agreed to withdraw its proposed Amendment No. 1 (H. R. Conference Report No. 2322, 79th Congress, 2nd Session, June 24, 1946; Toulmin's Trade Mark Act of 1946, p. 141).

That the Congress acted by design in eliminating the contestibility of marks registered under the Act of 1905 which are descriptive "of the character or quality" of the goods is evidenced by the final paragraph of Sec. 45 of Title X—Construction and Definitions (60 Stat. 443, Sec. 45; U. S. C. A., Tit. 15, Sec. 1127), which states, in part:

"The intent of this act is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce * * * to protect persons engaged in such commerce against unfair competition, to prevent *fraud and deception* in such commerce by the use of reproductions, copies, counterfeits, or colorable imitation of registered marks * * *." (Emphasis supplied.)

Therefore Congress changed the rule restricting registration of "descriptive" marks by omitting the provisions contained in the Act of 1905 and substituting therefor a prohibition only against marks that are "merely descriptive or deceptively misdescriptive".

POINT IV.

The trade mark "KWIXTART" applied to storage batteries is not "descriptive" within the prohibition of either trade mark act (Questions VII and VIII).

In the case of *Van Pelt & Brown, Inc. v. John Wyeth & Brother, Inc.*, (161 F. [2d] 244; 35 C. C. P. A. [Patents] ...) the Court of Customs and Patent Appeals in April, 1947, held, at page 247:

"Until the effective date of order No. 3804 of the Patent Office, it has been the settled law of this jurisdiction that the validity of a registered mark cannot be challenged in opposition proceedings, *Englander, Etc. v. Continental Distilling Co., supra*, and we are not now holding that such is not the law at the present time. However, that was the law at the time this proceeding was instituted and, of course, the law by which this case must be adjudicated."

That same Court has failed, a few months later, to follow that same rule in this case where "KWIXTART" was originally held in 1935 *not* "descriptive" but, at most, "suggestive" and registrable under the Act of 1905 under the law of the case of *Ex Parte Pillsbury Flour Mills Co.*, 1935 C. D. 1, 23 U. S. P. Q. 168, when "The doctrine of that case was the law of the Patent Office" (R. 65). This case should have been tested "by the law at the time" of registration.

In the case of *Hercules Powder Co. v. Newton*, 266 F. 169, 172, the Court held:

" 'Merely descriptive' means *only* descriptive, or *nothing more* than descriptive."

In the case of *Bailly v. Nashawannuck* (1890), (10 N. Y. Supp. 224) the Court, in considering the trademark "HY. GENIQUES" for suspenders, said:

"It is suggestive of the good quality of the suspender and of its usefulness', but it does not directly characterize the article, nor the methods which tend to make it healthful. At the outside such word is descriptive only in a modified or indirect sense, and, as it does not monopolize a part of the language essential or appropriate to describe the article, it may become the subject of a valid trademark. 'Words which are but inferentially or remotely descriptive, indicating neither origin nor ownership but merely some special quality or peculiarity of the article itself, may properly be regarded as fanciful or arbitrary in the legal sense'."

The trade mark involved "KWIXTART", is applied to batteries by applicant. "Battery" or "Storage Battery" would be "merely descriptive" of the goods. Obviously the mark involved is *not* "merely descriptive". It is also obvious that it is *not* "deceptively misdescriptive" of the goods. Hence, it obviously does not fall within the prohibited categories of the Lanham Act. A battery or storage battery is a depository of electric energy which is communicated or activated by closing the circuit or control of the conductor of the current. Obviously the mark KWIXTART does not describe the character, quality or function of the goods to which it is applied. The respondent concedes that KWIXTART is not "merely descriptive" of the batteries to which it is applied but places its position *solely* on the contention that KWIXTART describes one of the *functions* of the goods involved and not the character or quality of the goods. A motor or "starter" starts automobiles, motors, *not* the battery.

In *Arkell Safety Bag Co. v. Safepack Mills*, 289 Fed. 616, May 7, 1923, an opposition, the trade mark SAFE-PACK for wrapping paper was before the Court of Appeals of the District of Columbia under the Act of 1905. The opposer contended that the mark was descriptive of the goods. The Commissioner overruled this contention and the Court of Appeals affirmed the Commissioner. In so doing, the Court paraphrased the language of the Commissioner as follows:

"that if the component parts of the mark 'safepack' be considered, a variety of meanings, more or less fanciful, could be derived from it; that the mark, however, must be taken as a whole, and when so taken belongs to that class of arbitrary suggestive words that the commercial world is seeking; that, while it may be suggestive of certain characteristics, it is not descriptive to the extent of defining any particular quality of the goods to which it is applied; and hence that the contention of the Arkell Company with respect to it was not sound" (p. 617).

In *Plough, Inc. v. Intercity Oil Co. et al.*, 26 F. Supp. 978, Feb. 17, 1939 (also under the Act of 1905), the District Court for the Eastern District of Pennsylvania had to consider whether the trade-mark EVER READY for a lubricating oil was descriptive of the goods on which it was used. In deciding that it was not, the Court said:

"To justify a finding that the words are descriptive and the registration invalid * * * it must be shown that they apply especially to some ingredient, quality or characteristic of the lubricating oils under consideration. The words in question seem to have no particular reference to any ingredient or inherent characteristic or quality of oil. They suggest

merely that the product is prepared, is readily available, or is immediately usable, in the form of a word combination or catch phrase which, although frequently used, is no more descriptive of oil than of the scores of other commodities to which it is applied. We note also that the defendants themselves have so considered it, for they adopted and registered the name as their brand with the Pennsylvania Grade Crude Oil Association and have continuously sought to promote and protect it as a trade mark" (p. 981).

KWIXTART is not descriptive of electric storage batteries; it merely suggests that if the battery is used to drive the starter of an internal combustion engine, that engine will start quickly. If the battery were used to supply current for an electric lamp, or an electric motor, or any one of a dozen other electrical appliances that might be operated by a storage battery, the mark KWIXTART would not even be suggestive.

And in *Chrysler Corp. v. Rolland T. Trott*, 29 U. S. P. Q. 363, May 4, 1936, this Court held that the trade-mark "FLOATING POWER" was not descriptive of engine mountings, saying:

"We must hold, therefore, that, although appellant's trade-mark is *suggestive* of one of the characteristics of appellant's power plants, it does not *describe* its engine, power plants, or engine mountings, or any characteristic or quality possessed by them, * * *" (p. 370).

See also *Charles of the Ritz, Inc. v. Beth Arden Sales Corp.*, April 1947, 161 F. (2d) 234; 34 C. C. P. A. [Patents] . . ., relating to the trade mark "FEATHERLIGHT" for face cream, and *Vanity Fair Mills, Inc. v. Pedigree*

Fabrics, Inc., April 1947, 161 F. (2d) 226; 34 C. C. P. A. [Patents] ..., relating to the trade-mark "PECHGLO" for fabrics.

KWIXTART is in the same class as the marks in the quoted and cited cases. In each case the mark is *suggestive* rather than descriptive. The effect suggested by KWIXTART is too remote from the batteries themselves to render the mark descriptive of them.

Therefore, the petitioner's trade-mark KWIXTART is *not* "descriptive" of storage batteries within the prohibition of either of the Trade-Mark Acts of 1905 or 1946.

CONCLUSION.

Wherefore it is respectfully submitted that a writ of certiorari should be granted as prayed for.

Respectfully submitted,

EMMET L. HOLBROOK,
Attorney for Petitioner.

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APR 9 1948

CHARLES ELMORE BRIDGES
CLERK

IN THE
Supreme Court of the United States

October Term, 1947.

No. 664.

ANDREW J. McPARTLAND, INC.,
Petitioner,

vs.

MONTGOMERY WARD & CO., INC.

PETITIONER'S REPLY BRIEF.

EMMET L. HOLBROOK,
Attorney for Petitioner.

20/10/12
5/10

IN THE
Supreme Court of the United States

OCTOBER 1947 TERM.

ANDREW J. McPARTLAND, INC.,
Petitioner,

vs.

MONTGOMERY WARD & CO., INC.

No. 664.

PETITIONER'S REPLY BRIEF.

The respondent's opposition to this petition is placed, principally, upon an incomplete conception of our position and the decisions of this Court in *Postum Cereal Co. v. California Fig Nut Co.* (272 U. S. 693), *Pacific Northwest Canning Co. v. Skookum Packers Ass'n* (283 U. S. 858), *Fessenden v. Wilson* (284 U. S. 640), *Chase v. Avery* (307 U. S. 638) and *McBride v. Teeple* (311 U. S. 649).

The jurisdictional basis of our petition is: (1) the judgment of the Court of Customs and Patent Appeals *now is final*; (2) this matter is a "case" within the authoritative interpretations of the constitutional provisions creating this Court and, therefore, this Court has jurisdiction to review by writ of certiorari pursuant to Section 18 of the Trade Mark Act of February 20, 1905 (33 Stat. 729; U. S. C. A. Tit. 15, Sec. 98) and Section 40 of the Trade Mark Act of July 5, 1946 (60 Stat. 440; U. S. C. A. Tit. 15, Sec. 1122).

The first ground is based upon the fact that the amendment to the Patent Law of March 2, 1927 (44 Stat. 1336, Sec. 8; U. S. C. A. Tit. 35, Secs. 59a-63) eliminated the cumulative remedies provided by Secs. 4911-4915 of the Revised Statutes (16 Stat. 204, *et seq.*; U. S. C. A. Tit. 35, Secs. 59, *et seq.*) and excluded any further remedies after appeal to the Court of Customs and Patent Appeals from a decision of the Commissioner of Patents.

The second ground is predicated upon the usurpation by the Commissioner of Patents in 1944 of the judicial function, *not* granted to him by any of the statutes, to hear and determine as between the two parties hereto (a) that the trade-mark "KWIXTART", registered in 1935, is "descriptive" and not entitled to remain registered; (b) that said trade-mark is "descriptive" and that, therefore, petitioner was not entitled to the *exclusive use* of said trade-mark and, therefore, was not entitled to the *use* thereof at the time of applying for registration in 1935; (c) that the petitioner no longer is entitled to the *prima facie* evidence of his right to the *exclusive use* or to the access to the federal courts which the registration granted him in 1935 by the provisions of the Trade Mark Act. This deprivation by the Commissioner of petitioner's property—and a registration is property (*Hanover Star Milling Co. v. Metcalf*, 240 U. S. 357, 60 L. Ed. 713, and cases cited at page 29 of our Main Brief)—is not only an interference with property sufficient to characterize it "judicial action" within the rule of *Atkins v. Moore* (212 U. S. 285, 290) but the deprivation was accomplished without due process of law in violation of petitioner's constitutional rights which also is "judicial action". The usurpation of the judicial function without any natural or statutory authority was in and of itself "judicial action". *Atkins v. Moore*, 212 U. S. 285, 290.

The first distinction to be noted is that the cases cited in opposition to this application all involve opposition or interference proceedings, jurisdiction of which was con-

ferred specifically by statute upon the Commissioner, whatever judicial functions authoritatively exercised by him resulting in authorized administrative action. In our case neither the judicial function nor administrative action is authorized.

The *California Fig Nut Co.* and the *Fessenden* cases both lacked *finality* by reason of the cumulative remedies provided by Sections 4911-4915 of the Revised Statutes and whatever judicial functions were exercised were based upon the specific grant contained in the statute and resulted in administrative action authorized thereby.

The *Fessenden*, *Avery* and *McBride* cases were interference cases. The official report of the first two named merely show that a petition for writ of certiorari was denied without indicating that the disposition was on jurisdictional grounds. The same is true of the *Skookum Packing Co.* case. However, in the *McBride* case the report shows that the petition for writ of certiorari was denied for want of jurisdiction and cites the cases mentioned above. In the *McBride* case it should be noted that the Court of Customs and Patent Appeals modified a decision of the Board of Appeals of the Patent Office, affirming on Counts 2 to 7 inclusive and reversing on Count 1 and remanding the case to the Patent Office for further proceedings as to Count 1.

The Proctor & Gamble Co. cancellation proceedings were based on the lack of "the right to use" a mark, used for the first time in 1921 and registered in 1922, because it was confusingly similar to a mark which had been used and registered in 1913. It was held that the marks were confusingly similar and hence the substantive rule applied that the owner of the 1921 mark did not have "the right to use" it. On the facts, the power to hear and determine and to ~~cancel~~ were conferred by the Act. In our case, even if the mark was "descriptive"—and it is *not*—petitioner *would have* "the right to use it" even though its registration under the Trade-Mark Act would not be permitted and

the power to hear and determine or to cancel was *not* conferred by the Act.

No attempt was made in the *Proctor & Gamble* case to secure a writ of certiorari to have this Court review the decision of the Court of Customs and Patent Appeals which affirmed the Commissioner.

In the equity suit which followed the cancellation case, the Circuit Court of Appeals held that the decisions of the Commissioner and of the Court of Customs and Patent Appeals were *not res adjudicata* with respect to the "issue of cancellation" but that the District Court had no power to direct restoration of the registration. In brief, the decision holds that the decisions in the cancellation proceedings are *not res adjudicata* of the substantive rights existing separate and apart from those conferred by the Trade-Mark Act but that same *are res adjudicata* of the rights as between the parties to the benefits of registration under the Federal Act. This feature constitutes our matter a "case" within the Constitutional provisions.

In the cases relied on by respondent the statute conferred authority to exercise specified judicial or quasi-judicial functions which culminated in authorized administrative acts, elements wholly absent in our case. The absence of such elements render the judicial functions usurped in our case "judicial action" which, together with the finality now attaching to the judgment of the Court of Customs and Patent Appeals, constitutes this, the matter at Bar, a "case" of which this Court has jurisdiction to review.

CONCLUSION.

Wherefore it is respectfully submitted that a writ of certiorari should be granted as prayed for.

Respectfully submitted,

EMMET L. HOLBROOK,
Attorney for Petitioner.

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CHARLES ELMORE GOSFLEY
CLERK

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1947.

No. 664

ANDREW J. McPARTLAND, INC.,
Petitioner,

VS.

MONTGOMERY WARD & CO., INC.,
Respondent.

**BRIEF IN RESPONSE TO PETITION FOR
WRIT OF CERTIORARI.**

✓
STUART S. BALL,
HENRY R. MARSHALL,
619 W. Chicago Ave.,
Chicago, Illinois,
For Respondent.

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Respondent.

**BRIEF IN RESPONSE TO PETITION FOR
WRIT OF CERTIORARI**

This case originated as a simple Patent Office proceeding brought by Respondent to cancel Petitioner's trademark registration "KWIXTART" for electric storage batteries. Cancellation was recommended by the Examiner of Interferences and ordered by the Commissioner of Patents, whose decision was sustained by the Court of Customs and Patent Appeals (R. 64, 67, 120). Petitioner now seeks to have that decision reviewed by certiorari. Respondent believes that the Petition must be denied on the ground that this Court has no jurisdiction to

review a mere administrative action of this kind. Moreover, even if jurisdiction existed, the Petition would have to be denied for failure to state any substantial public interest warranting review by certiorari.

I.

This Court Lacks Jurisdiction to Review a Decision of the Court of Customs and Patent Appeals Sustaining the Cancellation of a Trade-mark Registration Since Such a Decision Is Merely Administrative and Not Judicial.

In arguing for the jurisdiction of this Court to grant certiorari in a Patent Office cancellation action, Petitioner has a formidable line of cases to overcome. In *Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693, this Court refused to review trade-mark proceedings commenced in the Patent Office and taken to the Court of Appeals for the District of Columbia (which, prior to 1929, exercised the jurisdiction now held by the Court of Customs and Patent Appeals in patent and trade-mark cases). Petitioner claims, however, that this case and others to the same effect can be distinguished.

Petitioner's argument, as we understand it, comes to this: Prior to 1927 decisions of the Court of Appeals of the District of Columbia on appeals from Patent Office decisions in trade-mark cases, pursuant to Section 4911, Revised Statutes (35 U.S.C.A., Sec. 59a), were not reviewable by this Court because not final. They were not final because the defeated litigant could subsequently seek the same relief by bill in equity, as provided in Section 4915, Revised Statutes (35 U.S.C.A., Sec. 63). After 1927, this alternative remedy was waived if a direct ap-

peal from a Patent Office decision was taken (Revised Statutes, Sec. 4911; 35 U.S.C.A., Sec. 59a).

The simple answer to Petitioner's argument is that decisions of the Court of Customs and Patent Appeals in trade-mark matters are still not *final*, because they are merely administrative rather than judicial in character and, hence, are not *res adjudicata* when like or related questions are raised in subsequent litigation.

Postum Cereal Co. v. California Fig Nut Co., *supra*, is still good law and is controlling in this case. The text of the case itself shows that Petitioner's purported distinction is not sound. The Postum Company filed a petition in the Patent Office to cancel the trade-mark "Fig Nuts," registered under the Act of 1920. The petition was denied by the Commissioner. The Court of Appeals for the District of Columbia held that it had no jurisdiction to hear an appeal in a proceeding to cancel a 1920 registration. The Postum Company thereupon sought a review in this court.

The Postum Company made the same argument for invoking the jurisdiction of the Court as Petitioner makes here and cited the same cases—*Shaffer v. Carter*, 252 U. S. 37; *Baldwin v. Robertson*, 265 U. S. 168. This Court said:

"We do not think this course of argument can be sustained. Assuming for the purposes of this discussion, that the District Court of Appeals was wrong

in not holding that section 9 of the act of 1905* did apply to the Commissioner of Patents' decision under the Act of 1920, even so, an appeal cannot be taken to this court to remedy the error. *The decision of the Court of Appeals under section 9 of the act of 1905 is not a judicial judgment. It is a mere administrative decision.* It is merely an instruction to the Commissioner of Patents by a court which is made part of the machinery of the Patent Office for administrative purposes. In the exercise of such function it does not enter a judgment binding parties in a case as the term case is used in the third article of the Constitution. Section 9 of the Trade-Mark Act of 1905, applies to the appeal taken under it the same rules which under section 4914, R.S. (Comp. St. Sec. 9459), apply to an appeal taken from the decision of the Commissioner of Patents in patent proceedings. *Butterworth v. Hoe*, 112 U. S. 50, 60, 5 S. Ct. 25, 28 L. Ed. 656; *Gaines v. Knecht*, 27 App. D. C. 530, 532; *Atkins v. Moore*, 212 U. S. 285, 291, 29 S. Ct. 390, 53 L. Ed. 515. Neither the opinion nor decision of the Court of Appeals under section 4914 R.S., or section 9 of the act of 1905, precludes any person interested from having the right to contest the validity of such patent or trade-mark in any court where it may be called in question. This result prevents an appeal to this court which can only review judicial judgments. This court has so decided in *Frasch v. Moore*, 211 U. S. 1, 29 S. Ct. 6, 53 L. Ed. 65, in an appeal as to patent proceedings, and in *Atkins v. Moore*, 212 U. S. 285, 29 S. Ct. 390, 53 L. Ed.

* "That if an applicant for registration of a trade-mark, or a party to an interference to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or a party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia, [now United States Court of Customs and Patent Appeals] on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable."

515 as to appeals in trade-mark proceedings. This was the *ratio decidendi* of *Baldwin v. Howard*, 256 U. S. 35, 41 S. Ct. 405, 65 L. Ed. 816, already referred to, where both appeal and certiorari were denied in a similar trade-mark proceeding.

"It was said in these cases that the appeal was denied because the action of the Court of Appeals was not a final judgment. This reason was a true one, but it should not be understood to imply that in such a proceeding, circumstances might give it a form that would make it a final judgment subject to review by this court. That is the error that the appellant here has made in pressing its appeal. Appellant relies on *Shaffer v. Carter*, 252 U. S. 37, 44, 40 S. Ct. 221, 64 L. Ed. 445, holding that a judgment of dismissal for lack of jurisdiction is a final judgment for purposes of appeal. But the citation has no application in such a case as this. For here the action of the Court of Appeals in its dismissal was dealing with something which even if it should have been received, was not in the proper sense a judgment at all. *Whatever the form of the action taken in respect of such an appeal, it is not cognizable in this court upon review, because the proceeding is a mere administrative one.*" (272 U. S. 698-700. Emphasis supplied.)

This language shows that Petitioner's labored explanation of the *Postum* case as resting on a change of statutory language in 1927 is wrong. This Court in the *Postum* case (having already denied certiorari, 266 U. S. 609) refused jurisdiction on appeal, not because the appellant's additional remedy by bill in equity under Section 4915, Revised Statutes, withdrew the attribute of finality from the Court of Appeals' decision, but because that decision was not a judgment at all but a mere administrative determination. The argument made by the appellant there, was exactly the same as Petitioner makes now; so that

the language quoted from that case disposes aptly and completely of Petitioner's contention.

If Petitioner's argument were sound, then after the amendment in 1927 of sections 4911 and 4915, Revised Statutes, whereby the two remedies became alternative rather than cumulative, the decisions of the Court of Customs and Patent Appeals in cases involving the purely administrative proceedings of the Patent Office—interferences, oppositions, cancellations and the disallowance of patent claims—having been made final in form, would have been reviewable by this Court on certiorari. This theory was tested in *Pacific Northwest Canning Co. v. Skookum Packers Association*, 45 F. 2d 912. That case was an opposition proceeding in the Patent Office. It came up to the Court of Customs and Patent Appeals in 1930—three years after the amendment of 1927 so much emphasized by Petitioner. The defeated party petitioned this Court for certiorari, which was refused in 283 U. S. 858. This was the entry:

“June 1, 1931. Per Curiam. The petition for writs of certiorari herein is denied for the want of jurisdiction. Section 240, Judicial Code; section 347, U. S. Code, Title 28 (28 U.S.C.A. Sec. 347); *Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693, 47 S. Ct. 284, 71 L. Ed. 478.”

In *Fessenden v. Wilson*, 284 U. S. 640; *Chase v. Avery*, 307 U. S. 638, and *McBride v. Teeple*, 311 U. S. 649, this Court refused certiorari to the Court of Customs and Patent Appeals in patent interference cases. The *McBride* case cited the *Postum* and *Skookum* cases as authorities for denial of certiorari.

Further affirmation of the basis of the *Postum* case—the distinction between the exercise of judicial and administrative functions and the lack of jurisdiction in this

Court to review the latter type, is found in *Proctor & Gamble Co. v. J. L. Prescott Co.* (C.C.A. 3rd), 102 F. 2d 773. Proctor & Gamble sued Prescott for trade-mark infringement, and Prescott counterclaimed for infringement of its trade-mark "Chase-O" by Proctor & Gamble's trade-mark "Chipso". Prior to this suit, Prescott had filed a petition in the Patent Office for cancellation of "Chipso". Cancellation was ordered by the Commissioner and sustained by the Court of Customs and Patent Appeals in *Proctor & Gamble Co. v. J. L. Prescott Co.*, 77 F. 2d 98. In the infringement suit Proctor & Gamble prayed that "Chipso" be restored to the trade-mark register in the Patent Office. Prescott argued and the District Court held that the decision of the Court of Customs and Patent Appeals affirming the cancellation order was *res adjudicata*. On that point the Circuit Court of Appeals reversed, holding on the authority of the *Postum* case that the decision of the Court of Customs and Patent Appeals in a cancellation proceeding was not *res adjudicata*. It held, however, that a District Court had no authority under the trade-mark statutes to reinstate a cancelled trade-mark to the Patent Office register. Certiorari was denied (308 U. S. 557).

The *Proctor & Gamble* case demonstrates that a decision of the Court of Customs and Patent Appeals sustaining cancellation of a trade-mark is not *res adjudicata* of the ownership or validity of such mark. Although "Chipso" was cancelled from the Patent Office register because it was held to be confusingly similar to "Chase-O" and Prescott was found to have had prior use and registration of its mark, Proctor & Gamble continued to use the "Chipso" mark, and the Circuit Court of Appeals refused to grant Prescott relief on its claim of infringement.

Petitioner fails to cite a single precedent for review by certiorari of a trade-mark cancellation proceeding. He does not bolster his position by the strained effort to qualify this action as a "case" under Section 40 of the Trade-Mark Act of 1946 (authorizing review of "cases" by certiorari) merely by citing various instances where the word "case" or "cases" is used in the Act (Pet. 26-29). The question is one of the exercise of judicial powers under the Constitution and, therefore, must be decided by the concepts embraced in Section 2, Article 3 of the Constitution, conferring on federal courts judicial power in "all cases, in law and equity, arising under the Constitution * * *". The question cannot be decided by reference to the manner in which the word "case" is used in any particular statute.

Petitioner cites *Baldwin Co. v. Robertson*, 265 U. S. 168, as an example of a trade-mark case reviewed by appeal to this Court (Pet. 29). There is no comfort for Petitioner in that case, however, for it was not a Patent Office proceeding but a bill in equity for an injunction restraining the Commissioner of Patents from cancelling trade-mark registrations; and, furthermore, it was brought only *after* a petition for certiorari in the cancellation proceeding itself had been refused by this Court. *Baldwin v. Howard*, 256 U. S. 35.

Petitioner cites *Atkins v. Moore*, 212 U. S. 285, for the proposition that in a cancellation proceeding the Commissioner of Patents acts in a judicial capacity (Pet. 29). The case holds the contrary. The language in that case to which Petitioner apparently refers was quoted with ap-

proval from *Gaines v. Knecht*, 27 App. D. C. 530 (writ of error dismissed, 212 U. S. 561), which was a trade-mark opposition proceeding. The quotation was as follows:

“It may be true that the Commissioner acts in a judicial capacity in determining whether the applicant is the owner of the trade-mark, and whether it is one of those marks the registration of which is prohibited; but, when he has determined these in favor of the applicant, the act to be performed by him is ministerial merely, and that is the act which it is claimed he should have refused to perform, on the ground that the statute is unconstitutional. Such judicial proceedings as there are issue and culminate in a purely ministerial act—the mere registration of a mark * * *” 212 U. S. 290.

Clearly the Court was saying that, although there might be elements of adjudication in determining the issues in Patent Office proceedings, the final decisions therein were purely administrative in character—and it is the decisions from which appeals are taken.

Nothing that Petitioner has said in his argument for jurisdiction can have any persuasion in the teeth of the unwavering line of authorities from *Frasch v. Moore*, 211 U. S. 1, to *McBride v. Teeple*, 311 U. S. 649.

II.

No Substantial Public Interest Is Involved in This Case.

The Court below decided that the trade-mark “KWIX-TART” was descriptive of electric storage batteries (R. 122). It decided further that the Trade-Mark Act of 1946 did not apply to the appeal in this case, but that even if it did the disposition of the case was not affected, because Section 2 (e) of the new Act, which prohibits registration of a mark “which, (1) when applied to the goods of the applicant is merely descriptive * * * of them” does not

permit registration of a mark which is descriptive "of the character or quality of such goods" (R. 128-9).

It seems self-evident that there is nothing revolutionary or challenging to the public interest in these propositions. They are relatively simple conclusions deducible from principles of reason as well as the precepts of law stated by the court. Petitioner cites no decisions of this Court with which the decision below conflicts in principle. He cites several decisions of the Commissioner of Patents, Court of Customs and Patent Appeals and District Courts holding certain marks not to be descriptive, and alleges that the decision conflicts with them. But the issue of the descriptiveness of a particular mark is not one to be settled by reference to prior decisions. Who can say whether "KWIXTART" is or is not descriptive of electric storage batteries because "MINITMIX" is not descriptive of prepared biscuit flour (*Ex Parte Pillsbury Co.*, 23 U.S.P.Q. 168) while "QUIKMIX" is (*Hershey Chocolate Corp. v. Commercial Milling Co.*, 28 U.S.P.Q. 29)? As the Court of Customs and Patent Appeals said in *International Vitamin Corporation v. Winthrop Chemical Co.*, 147 F. 2d 1016, 1017-18:

"Many cases have been cited by both parties, but as we have often held in trade-mark litigation such as comes to this court, each case must of necessity be decided on its own facts, and precedents are of little help in deciding such cases. *In re Dutch Maid Ice Cream Company*, 95 F. 2d 262, 25 C.C.P.A., Patents, 1009."

Even if jurisdiction were present in this case, therefore, there is no such public interest or such confusion or conflict at law as would justify its exercise.

The Petition for writ of certiorari must be denied.

Respectfully submitted,

STUART S. BALL,

HENRY R. MARSHALL,

Attorneys for Respondent.

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